

REMARKS

Claims 1-29 and 103 are pending in this application. Claims 30-83 and 89-102, which were previously withdrawn pursuant to Applicants' reply to a restriction requirement, have been cancelled without prejudice as requested by the Examiner. Claim 1 has been amended to recite a limitation implicit in the claim as originally drawn. New claim 103 recites a system for implementing the method defined in claim 1. A word in paragraph 0036 of the specification has been deleted to correct a typographical error. No new matter is added.

Elections/Restrictions

Applicants note that they elected claims 1-29 for examination in this Application with traverse. The 5-19-2005 office action initially indicates that Applicants elected claims with traverse, which is correct, but then indicates that claims 1-29 were elected without traverse, which is incorrect.

Claim Rejections – 35 U.S.C. § 101

The Examiner has rejected claims 1-29 as allegedly “hav[ing] no connection to the technological arts” because neither the preamble nor the steps in the methods supposedly have any “connection to a computer or technology” (O.A. at 5). Applicants respectfully disagree.

Each of claims 1-29 recites a method of formulating individualized product recommendations that includes the steps of “operating on the inputs with a data processing portion of the [intelligent performance-based] product recommendation engine” and “producing a set of outputs from the data processing portion of the product recommendation engine.” These steps in the claims are connected to a computer or technology (*see, e.g.*, “Data Processing” section in Applicants' specification beginning at paragraph 0097). Thus, all of the claims recite statutory subject matter.

Applicants nonetheless have amended the claims to explicitly recite that which was already implicit -- that the generating step of the method claims is done “with the assistance of one or more computing devices.” However, Applicants explicitly note that this amendment is a matter of form only and neither broadens nor narrows the substantive scope of the claims. Applicants' therefore surrender absolutely no range of equivalents, disclaim

absolutely no claim coverage, and forego no other rights that otherwise would exist as if the claims issued as originally drawn.

Applicants respectfully request that the rejections based on 35 U.S.C. § 101 be withdrawn.

Claim Rejections – 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-8, 18-22, and 28-29 as allegedly being anticipated by Wilmott et al. (U.S. Pat. No. 6,782,307) under 35 U.S.C. § 102(e). Applicants respectfully disagree.

Wilmott's 102(e) Date is After the Priority Date of this Application

Applicants dispute that Wilmott is prior art to the claims in this Application. The claims in this Application have a priority date of at least as early as 10-18-2000 by virtue of the benefit claim to provisional patent application no. 60/241,405 (*see* paragraph 001 in Applicants' specification). Wilmott on the other hand, is entitled to a priority date of only 01-31-2001 or later for at least the following two reasons.

The current version of § 102(e), which Applicants contend is inapplicable to Wilmott (see reason 2 below), states that "[a] person shall be entitled to a patent unless – [] (e) the invention was described in [] (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) [i.e., the PCT] shall have the effect for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language." 35 U.S.C. § 102(e). Wilmott is a U.S. patent granted on an application for patent filed in the U.S. as a continuation of PCT application no. PCT/US01/03168, which was filed on 01-31-2001. The PCT application appears to have designated the U.S. and have been published in the English language. Thus, under the current version of the statute, assuming for now that it applies, Wilmott would initially appear to be prior art under § 102(e) as of 01-31-2001, which is after the priority date of Applicants' claims.

Applicants therefore presume that the Examiner is taking the position that Wilmott is prior art under § 102(e) as of the date(s) of the three provisional applications that Wilmott

claims the benefit of, which were filed on 1-31-2000, 3-23-2000, and 7-7-2000 respectively. However, that position is an incorrect application of both the current and immediately preceding versions of §102(e).

First, the operation of §102(e) is subject to the provisions of 35 U.S.C. §§363 *and* 119(e)(1), and §119(e)(1) precludes utilizing the Wilmott provisional application filing dates under §102(e). Section 363 states that “[a]n international application designating the United States shall have the effect, from its international filing date under Article 11 of the [PCT], of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.” 35 U.S.C. §363. However, §119(e)(1) states that “[a]n *application* for patent filed under ... section 363 of this title for an invention disclosed ... in a provisional application filed under section 111(b) ... shall have the same effect, as to such invention, as though filed on the date of the provisional application ... *if the application* for patent filed under ... section 363 of this title [i.e., the international application] ... contains ... a specific reference to the provisional application.” *Id.* (emphasis added). The international application that Wilmott is based upon failed to contain “a specific reference to” any of the three provisional applications (*see* WO 01/058238 A2). Accordingly, Wilmott’s §102(e) date under the current version of the statute is 01-31-2001 or later, which results in Wilmott not being prior art to this Application.

Second, even if one were to assume that the Wilmott international application complied with §119(e)(1) so as to allow reliance on the three Wilmott provisionals for §102(e) purposes, which it did not, the combination of §119(e)(1), the enabling legislation for the current version of §102(e), and the immediately preceding version of §102(e) precludes utilizing the dates of the three Wilmott provisional applications under §102(e).¹

In November 2002, §13205 of Public Law 107-273 implemented the current version of §102(e). Pub. L. 107-273, 116 Stat. 1758 (11-2-2002)(excerpts attached as Exhibit A). As noted above, in order for Wilmott to be considered prior art to Applicants’ claims, Wilmott must be entitled to claim the benefit of the three Wilmott provisional applications under §119(e)(1). Assuming for purposes of argument that §119(e)(1) is satisfied, which it is not, then the Wilmott international application is considered to have been filed on any of the three

¹ The portions of 35 U.S.C. §119(e)(1) relevant to this Reply and noted above have been in effect since 1995. Pub. L. 103-465.

provisional filing dates – 1-31-2000, 3-23-2000, or 7-7-2000. This is, however, an impermissible application of the statute because the legislation that implemented the current version of §102(e) forbids it. Section 3205 of Public Law No. 107-273 explicitly states that “*Patents resulting from an international application filed before November 29, 2000 ... shall not be effective as prior art as of the filing date of the international application; however such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.*” *Id.* (emphasis added). Thus, Wilmott cannot be, and is not, prior art to Applicants’ claims under the current version of §102(e).

Nor is Wilmott prior art to Applicants’ claims under the immediately preceding version of §102(e). That version of §102(e) provided that a person shall be entitled to a patent unless:

“The invention was described in-- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).”

Pub. L. 106-113, 113 Stat. 1501 §4505 (11-29-1999)(excerpts attached as Exhibit B).

Under this earlier version of §102(e) U.S. patents based on international applications were only afforded §102(e) dates as of the U.S. application filing date, not the priority date that the international application itself was entitled to. *Id.* Wilmott’s U.S. filing date was 10-1-2001, well after Applicants’ priority date of 10-18-2000.

Accordingly, Wilmott is not prior art to Applicants’ claims.

Wilmott Does Not Anticipate Applicants’ Claims

Assuming for purposes of argument only that Wilmott is prior art, which it is not, Wilmott does not anticipate (or even render obvious) the claims pending in this Application. Applicants explicitly note that while they will address Wilmott on the merits, they do so only

because MPEP §714.02 requires them to do so. Applicants' therefore reserve all rights to exert the full scope of the claimed subject matter (e.g., to assert infringement over equivalent subject matter, to receive unrestricted claim coverage, etc.) as though arguments on the merits were never made should the Examiner agree, or it be otherwise determined, that Wilmott is not prior art to the claims in this Application.

In order to allegedly anticipate Applicants' claims, Wilmott must, by itself, disclose each limitation in Applicants' claims. *Nystrom v. Trex Co.*, 374 F.3d 1105, 1117-18 (Fed. Cir. 2004)(reversing summary judgment of anticipation because prior art reference failed to disclose each limitation of claim). Moreover, Wilmott's disclosure must not only disclose every limitation in Applicants' claims, it also must enable Applicants' claims. *Smithkline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1342 (Fed. Cir. 2005)("For prior art to anticipate a claim it must be sufficient to enable one with ordinary skill in the art to practice the invention.")(quotations omitted); *PPG Indus. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996)(affirming grant of preliminary injunction, stating that to "anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter"). Wilmott fails to do either for at least the following reasons.

First, Wilmott does not teach or disclose "generating a set of individualized product recommendations for the consumer from a plurality of products within a product category" by "operating on the inputs [received from a consumer] with a data processing portion of the [intelligent performance-based] product recommendation engine" (*see* Claims 1 and 103). *In general*, the way that Applicants' claimed product recommendation engine generates individualized product recommendations for a particular consumer is by classifying the particular consumer in a relevant portion of a larger population of persons who exhibited suitably similar objective and/or subjective characteristics as the those contained in the particular consumer's inputs and who used products with some known level of performance for a concern(s) that is relevant to the particular consumer based on the consumer's inputs. Based on that classification in a relevant portion of a larger population of persons who used products in the past (which could include the particular consumer him- or herself), Applicants' product recommendation engine generates a set of products that is predicted to have a certain probability(ies) or chance(s) of addressing the particular consumer's concern(s)

based on the recommended products' past performance (*e.g.*, Applicants' Specification at paragraphs 0087; *see also* paragraphs 0031-0036). In other words, in Applicant's claimed methods and system the "set of individualized product recommendations" are generated based on an intelligent assessment of where the particular consumer fits vis-a-vis a population of persons who had the same or suitably similar concerns, exhibited the same or suitably similar subjective and/or objective characteristics, and who used various products to address those concerns with some level of performance in the past (*e.g.*, no success, some success, very successful, exacerbated concern(s), etc.). While there are numerous ways to specifically implement Applicants' claimed system and methods as detailed at length in Applicants' specification, and the foregoing general description is not intended to limit the full range of implementations supported by Applicants' detailed specification, the overall approach to generating individualized product recommendations in Applicants' claimed methods and system is markedly different from the systems and methods taught by Wilmott.

Wilmott teaches nothing more than systems and methods for generating a customized formulation of a cosmetic or pharmaceutical that will have the specific characteristics dictated by the user, with some changes to the customized formulation being possible based on external factors "such as where the user intends to use the product, the time of year, local weather, etc." (Col. 3, line 67-Col. 4, line 40: stating that users "indicate how they would like the product customized. ... the user can be permitted to specify the actual or relative quantity of the active agent to be added. ... Alternatively, [] the user is prompted to select the desired characteristics of the product. ... For example, a user may request a moisturizing lotion which includes a sun-screen agent"; Col. 5, lines 23-25). While this in itself is quite different than the novel subject matter defined by Applicants' claims (*see supra*), Wilmott also does *not* generate its customized formulation *based on the past performance of that formulation* (or any other formulation its or other systems and methods have generated for that matter) *by previous persons who had suitably similar concerns* they wanted addressed (Col. 4, lines 44-6: "Based on the properties and characteristics of the customized product specified by the user, and possibly the user's profile, an initial cosmetic formulation is selected"; Col. 3, lines 35-39: describing information in user profile: Col. 5, lines 5-22: "Once a [initial] formulation has been selected, it is modified using knowledge of how changes in quantity of various additives to the base composition effect the final product to provide a formulation which

meets the user's specific customization selection.... Continuing the SPF example, if the user has specified an SPF of 4.5, the closes predefined formulation may be for an SPF 4 have a defined quantity of Q1 of additive A. Based on knowledge of how the SPF varies with variations in the quantity of additive A, the amount of A in the formula is adjusted to achieve the desired SPF rating").

In fact, Wilmott's systems and methods of generating a customized cosmetic or pharmaceutical formulation do *not* even *classify a user vis-a-vis a relevant population of prior persons who used the customized formulation* or a suitably similar customized formulation as the one generated for the particular user (*id.*; Col. 3, lines 54-65). Thus, unlike Applicants' claimed methods and system, Wilmott does *not* generate a recommended product by intelligently assessing where a particular consumer fits vis-a-vis past consumers or persons who had suitably similar concerns, exhibited suitably similar subjective and/or objective characteristics, and used products to address those concerns with some level of performance.

Finally, to the extent the Examiner were to maintain that Wilmott does teach or disclose generating a recommended product formulation by intelligently assessing where a particular consumer fits vis-a-vis past consumers or persons who had suitably similar concerns, exhibited suitably similar subjective and/or objective characteristics, and used products to address those concerns with some level of performance, then Wilmott utterly fails to enable this subject matter. *Smithkline Beecham*, 403 F.3d at 1342; *PPG Indus.*, 75 F.3d at 1566. First of all, as noted above, Wilmott makes no mention whatever of considering how past formulations generated by its system (or by any other system or source) performed in the past when generating its current formulations; and Wilmott makes no mention whatever of considering how the current user of its systems and methods compares to a population of persons who used the presently recommended formulation (or any other formulation) in the process of generating the presently recommended formula. Thus, it is difficult to fathom how Wilmott could enable one having ordinary skill in the art to make and use subject matter Wilmott makes no mention of whatsoever. Finally, Wilmott's "custom formulation software system" disclosure is meager at best, and does not even begin to provide the information necessary to enable one having ordinary skill in the art to implement and use a method or system for generating a set of individual product recommendations by intelligently assessing

where a particular consumer fits vis-a-vis past consumers or persons who had suitably similar concerns, exhibited suitably similar subjective and/or objective characteristics, and used products to address those concerns with some level of performance (Col. 20, lines 20-37: stating nothing more than that a “custom product selection module 62 provides users of the system with appropriate customization forms for the product of interest, perhaps with reference to customization information stored in a formulation database 68. The custom product selection information is fed into a formulation generator 64 which, with reference to appropriate information in the formulation database 68, selects the predefined formulation, modifies it in accordance with the user’s product selection and perhaps with the user profile stored in the database 18 and/or various external factors which are programmed into the system or provided via an external port”; Col. 5, lines 23-32: stating that “external factors” include things “such as where the user intends to use the product, the time of year, local weather, etc.”).

Accordingly, even if Wilmott were considered prior art, which it is not, Wilmott fails to anticipate Applicants’ claims.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 9-12 under 35 U.S.C. §103(a) as allegedly being obvious over Wilmott. For the reasons noted above in connection with the §102 rejections, the rejections of claims 9-12 based on Wilmott cannot stand either.

DOCKET NO.: JJCC-0003
Application No.: 09/981,516
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PATENT

Conclusion

For at least the reasons noted above, none of the claim rejections can stand and all should be withdrawn. Applicants' claims define novel, patentable subject matter and are in a condition for the earliest possible allowance.

Respectfully submitted,

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David L. Marcus
Registration No. 46,897

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

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PATENT

A

PUBLIC LAW 107-273—NOV. 2, 2002

**21ST CENTURY DEPARTMENT OF JUSTICE
APPROPRIATIONS AUTHORIZATION ACT**

Public Law 107-273
107th Congress

An Act

Nov. 2, 2002
[H.R. 2215]

To authorize appropriations for the Department of Justice for fiscal year 2002, and for other purposes.

21st Century
Department of
Justice
Appropriations
Authorization
Act.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE; TABLE OF CONTENTS.

(a) **SHORT TITLE.**—This Act may be cited as the “21st Century Department of Justice Appropriations Authorization Act”.

(b) **TABLE OF CONTENTS.**—The table of contents of this Act is as follows:

**DIVISION A—21ST CENTURY DEPARTMENT OF JUSTICE APPROPRIATIONS
AUTHORIZATION ACT**

**TITLE I—AUTHORIZATION OF APPROPRIATIONS FOR FISCAL YEARS 2002
AND 2003**

- Sec. 101. Specific sums authorized to be appropriated for fiscal year 2002.
- Sec. 102. Specific sums authorized to be appropriated for fiscal year 2003.
- Sec. 103. Appointment of additional assistant United States attorneys; reduction of certain litigation positions.
- Sec. 104. Authorization for additional assistant United States attorneys for project safe neighborhoods.

TITLE II—PERMANENT ENABLING PROVISIONS

- Sec. 201. Permanent authority.
- Sec. 202. Permanent authority relating to enforcement of laws.
- Sec. 203. Miscellaneous uses of funds; technical amendments.
- Sec. 204. Technical and miscellaneous amendments to Department of Justice authorities; authority to transfer property of marginal value; record-keeping; protection of the Attorney General.
- Sec. 205. Oversight; waste, fraud, and abuse within the Department of Justice.
- Sec. 206. Enforcement of Federal criminal laws by Attorney General.
- Sec. 207. Strengthening law enforcement in United States territories, commonwealths, and possessions.

TITLE III—MISCELLANEOUS

- Sec. 301. Repealers.
- Sec. 302. Technical amendments to title 18 of the United States Code.
- Sec. 303. Required submission of proposed authorization of appropriations for the Department of Justice for fiscal years 2004 and 2005.
- Sec. 304. Study of untested rape examination kits.
- Sec. 305. Reports on use of DCS 1000 (Carnivore).
- Sec. 306. Study of allocation of litigating attorneys.
- Sec. 307. Use of truth-in-sentencing and violent offender incarceration grants.
- Sec. 308. Authority of the Department of Justice Inspector General.
- Sec. 309. Review of the Department of Justice.
- Sec. 310. Authorization of appropriations.
- Sec. 311. Report on threats and assaults against Federal law enforcement officers, United States judges, United States officials and their families.
- Sec. 312. Additional Federal judgeships.

TITLE IV—VIOLENCE AGAINST WOMEN

- Sec. 401. Short title.

- Sec. 402. Establishment of Violence Against Women Office.
Sec. 403. Effective date.

DIVISION B—MISCELLANEOUS DIVISION

TITLE I—BOYS AND GIRLS CLUBS OF AMERICA

- Sec. 1101. Boys and Girls Clubs of America.

TITLE II—DRUG ABUSE EDUCATION, PREVENTION, AND TREATMENT ACT
OF 2002

- Sec. 2001. Short title.

Subtitle A—Drug-Free Prisons and Jails

- Sec. 2101. Use of residential substance abuse treatment grants to provide for services during and after incarceration.
Sec. 2102. Jail-based substance abuse treatment programs.
Sec. 2103. Mandatory revocation of probation and supervised release for failing a drug test.

Subtitle B—Treatment and Prevention

- Sec. 2201. Report on drug-testing technologies.
Sec. 2202. Drug and substance abuse treatment, prevention, education, and research study.
Sec. 2203. Drug abuse and addiction research.

Subtitle C—Drug Courts

- Sec. 2301. Drug courts.
Sec. 2302. Authorization of appropriations.
Sec. 2303. Study by the General Accounting Office.

Subtitle D—Program for Successful Reentry of Criminal Offenders Into Local
CommunitiesCHAPTER 1—POST INCARCERATION VOCATIONAL AND REMEDIAL EDUCATIONAL
OPPORTUNITIES FOR INMATES

- Sec. 2411. Post incarceration vocational and remedial educational opportunities for inmates.

CHAPTER 2—STATE REENTRY GRANT PROGRAMS

- Sec. 2421. Amendments to the Omnibus Crime Control and Safe Streets Act of 1968.

Subtitle E—Other Matters

- Sec. 2501. Amendment to Controlled Substances Act.
Sec. 2502. Study of methamphetamine treatment.
Sec. 2503. Authorization of funds for DEA police training in South and Central Asia.
Sec. 2504. United States-Thailand drug prosecutor exchange program.

TITLE III—SAFEGUARDING THE INTEGRITY OF THE CRIMINAL JUSTICE
SYSTEM

- Sec. 3001. Increasing the penalty for using physical force to tamper with witnesses, victims, or informants.
Sec. 3002. Correction of aberrant statutes to permit imposition of both a fine and imprisonment.
Sec. 3003. Reinstatement of counts dismissed pursuant to a plea agreement.
Sec. 3004. Appeals from certain dismissals.
Sec. 3005. Clarification of length of supervised release terms in controlled substance cases.
Sec. 3006. Authority of court to impose a sentence of probation or supervised release when reducing a sentence of imprisonment in certain cases.
Sec. 3007. Clarification that making restitution is a proper condition of supervised release.

TITLE IV—CRIMINAL LAW TECHNICAL AMENDMENTS ACT OF 2002

- Sec. 4001. Short title.
Sec. 4002. Technical amendments relating to criminal law and procedure.
Sec. 4003. Additional technicals.
Sec. 4004. Repeal of outmoded provisions.

- Sec. 4005. Amendments resulting from Public Law 107-56.
- Sec. 4006. Cross reference correction.

TITLE V—PAUL COVERDELL FORENSIC SCIENCES IMPROVEMENT GRANTS

- Sec. 5001. Paul Coverdell Forensic Sciences Improvement Grants.
- Sec. 5002. Authorization of appropriations.

DIVISION C—IMPROVEMENTS TO CRIMINAL JUSTICE, CIVIL JUSTICE, IMMIGRATION, JUVENILE JUSTICE, AND INTELLECTUAL PROPERTY AND ANTITRUST LAWS

TITLE I—CRIMINAL JUSTICE, CIVIL JUSTICE, AND IMMIGRATION

Subtitle A—General Improvements

- Sec. 11001. Law Enforcement Tribute Act.
- Sec. 11002. Disclosure of grand jury matters relating to money laundering offenses.
- Sec. 11003. Grant program for State and local domestic preparedness support.
- Sec. 11004. United States Sentencing Commission access to NCIC terminal.
- Sec. 11005. Danger pay for FBI agents.
- Sec. 11006. Police corps.
- Sec. 11007. Radiation exposure compensation technical amendments.
- Sec. 11008. Federal Judiciary Protection Act of 2002.
- Sec. 11009. James Gueff and Chris McCurley Body Armor Act of 2002.
- Sec. 11010. Persons authorized to serve search warrant.
- Sec. 11011. Study on reentry, mental illness, and public safety.
- Sec. 11012. Technical amendment to Omnibus Crime Control Act.
- Sec. 11013. Debt collection improvement.
- Sec. 11014. SCAAP authorization.
- Sec. 11015. Use of annuity brokers in structured settlements.
- Sec. 11016. INS processing fees.
- Sec. 11017. United States Parole Commission extension.
- Sec. 11018. Waiver of foreign country residence requirement with respect to international medical graduates.
- Sec. 11019. Pretrial disclosure of expert testimony relating to defendant's mental condition.
- Sec. 11020. Multiparty, Multiforum Trial Jurisdiction Act of 2002.
- Sec. 11021. Additional place of holding court in the southern district of Ohio.
- Sec. 11022. Direct shipment of wine.
- Sec. 11023. Webster Commission implementation report.
- Sec. 11024. FBI police.
- Sec. 11025. Report on FBI information management and technology.
- Sec. 11026. GAO report on crime statistics reporting.
- Sec. 11027. Crime-free rural States grants.
- Sec. 11028. Motor vehicle franchise contract dispute resolution process.
- Sec. 11029. Holding court for the southern district of Iowa.
- Sec. 11030. Posthumous citizenship restoration.
- Sec. 11030A. Extension of H-1B status for aliens with lengthy adjudications.
- Sec. 11030B. Application for naturalization by alternative applicant if citizen parent has died.

Subtitle B—EB-5 Amendments

CHAPTER 1—IMMIGRATION BENEFITS

- Sec. 11031. Removal of conditional basis of permanent resident status for certain alien entrepreneurs, spouses, and children.
- Sec. 11032. Conditional permanent resident status for certain alien entrepreneurs, spouses, and children.
- Sec. 11033. Regulations.
- Sec. 11034. Definitions.

CHAPTER 2—AMENDMENTS TO OTHER LAWS

- Sec. 11035. Definition of "full-time employment".
- Sec. 11036. Eliminating enterprise establishment requirement for alien entrepreneurs.
- Sec. 11037. Amendments to pilot immigration program for regional centers to promote economic growth.

Subtitle C—Judicial Improvements Act of 2002

- Sec. 11041. Short title.
- Sec. 11042. Judicial discipline procedures.
- Sec. 11043. Technical amendments.

Sec. 11044. Severability.

Subtitle D—Antitrust Modernization Commission Act of 2002

- Sec. 11051. Short title.
- Sec. 11052. Establishment.
- Sec. 11053. Duties of the Commission.
- Sec. 11054. Membership.
- Sec. 11055. Compensation of the Commission.
- Sec. 11056. Staff of Commission; experts and consultants.
- Sec. 11057. Powers of the Commission.
- Sec. 11058. Report.
- Sec. 11059. Termination of Commission.
- Sec. 11060. Authorization of appropriations.

TITLE II—JUVENILE JUSTICE

Subtitle A—Juvenile Offender Accountability

- Sec. 12101. Short title.
- Sec. 12102. Juvenile offender accountability.

Subtitle B—Juvenile Justice and Delinquency Prevention Act of 2002

- Sec. 12201. Short title.
- Sec. 12202. Findings.
- Sec. 12203. Purpose.
- Sec. 12204. Definitions.
- Sec. 12205. Concentration of Federal effort.
- Sec. 12206. Coordinating Council on Juvenile Justice and Delinquency Prevention.
- Sec. 12207. Annual report.
- Sec. 12208. Allocation.
- Sec. 12209. State plans.
- Sec. 12210. Juvenile delinquency prevention block grant program.
- Sec. 12211. Research; evaluation; technical assistance; training.
- Sec. 12212. Demonstration projects.
- Sec. 12213. Authorization of appropriations.
- Sec. 12214. Administrative authority.
- Sec. 12215. Use of funds.
- Sec. 12216. Limitations on use of funds.
- Sec. 12217. Rules of construction.
- Sec. 12218. Leasing surplus Federal property.
- Sec. 12219. Issuance of rules.
- Sec. 12220. Content of materials.
- Sec. 12221. Technical and conforming amendments.
- Sec. 12222. Incentive grants for local delinquency prevention programs.
- Sec. 12223. Effective date; application of amendments.

Subtitle C—Juvenile Disposition Hearing

- Sec. 12301. Juvenile disposition hearing.

TITLE III—INTELLECTUAL PROPERTY

Subtitle A—Patent and Trademark Office Authorization

- Sec. 13101. Short title.
- Sec. 13102. Authorization of amounts available to the Patent and Trademark Office.
- Sec. 13103. Electronic filing and processing of patent and trademark applications.
- Sec. 13104. Strategic plan.
- Sec. 13105. Determination of substantial new question of patentability in reexamination proceedings.
- Sec. 13106. Appeals in inter partes reexamination proceedings.

Subtitle B—Intellectual Property and High Technology Technical Amendments

- Sec. 13201. Short title.
- Sec. 13202. Clarification of Reexamination Procedure Act of 1999; technical amendments.
- Sec. 13203. Patent and Trademark Efficiency Act amendments.
- Sec. 13204. Domestic publication of foreign filed Patent Applications Act of 1999 amendments.
- Sec. 13205. Domestic publication of patent applications published abroad.
- Sec. 13206. Miscellaneous clerical amendments.
- Sec. 13207. Technical corrections in trademark law.
- Sec. 13208. Patent and trademark fee clerical amendment.

- Sec. 13209. Copyright related corrections to 1999 Omnibus Reform Act.
Sec. 13210. Amendments to title 17, United States Code.
Sec. 13211. Other copyright related technical amendments.

Subtitle C—Educational Use Copyright Exemption

- Sec. 13301. Educational use copyright exemption.

Subtitle D—Madrid Protocol Implementation

- Sec. 13401. Short title.
Sec. 13402. Provisions to implement the protocol relating to the Madrid Agreement concerning the international registration of marks.
Sec. 13403. Effective date.

TITLE IV—ANTITRUST TECHNICAL CORRECTIONS ACT OF 2002

- Sec. 14101. Short title.
Sec. 14102. Amendments.
Sec. 14103. Effective date; application of amendments.

DIVISION A—21ST CENTURY DEPARTMENT OF JUSTICE APPROPRIATIONS AUTHORIZATION ACT

TITLE I—AUTHORIZATION OF APPROPRIATIONS FOR FISCAL YEARS 2002 AND 2003

SEC. 101. SPECIFIC SUMS AUTHORIZED TO BE APPROPRIATED FOR FISCAL YEAR 2002.

There are authorized to be appropriated for fiscal year 2002, to carry out the activities of the Department of Justice (including any bureau, office, board, division, commission, subdivision, unit, or other component thereof), the following sums:

(1) GENERAL ADMINISTRATION.—For General Administration: \$92,668,000.

(2) ADMINISTRATIVE REVIEW AND APPEALS.—For Administrative Review and Appeals: \$173,647,000 for administration of pardon and clemency petitions and for immigration-related activities.

(3) OFFICE OF INSPECTOR GENERAL.—For the Office of Inspector General: \$50,735,000, which shall include for each such fiscal year, not to exceed \$10,000 to meet unforeseen emergencies of a confidential character.

(4) GENERAL LEGAL ACTIVITIES.—For General Legal Activities: \$549,176,000, which shall include for each such fiscal year—

(A) not less than \$4,000,000 for the investigation and prosecution of denaturalization and deportation cases involving alleged Nazi war criminals; and

(B) not to exceed \$20,000 to meet unforeseen emergencies of a confidential character.

(5) ANTITRUST DIVISION.—For the Antitrust Division: \$130,791,000.

(6) UNITED STATES ATTORNEYS.—For United States Attorneys: \$1,353,968,000, which shall include not less than \$10,000,000 for the investigation and prosecution of intellectual property crimes, including software counterfeiting crimes and

“(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.”.

(b) **APPEAL TO BOARD OF PATENT APPEALS AND INTERFERENCES.**—Section 134(c) of title 35, United States Code, is amended by striking the last sentence.

(c) **APPEAL TO COURT OF APPEALS FOR THE FEDERAL CIRCUIT.**—Section 141 of title 35, United States Code, is amended in the third sentence by inserting “, or a third-party requester in an inter partes reexamination proceeding, who is” after “patent owner”.

(d) **EFFECTIVE DATE.**—The amendments made by this section apply with respect to any reexamination proceeding commenced on or after the date of enactment of this Act.

35 USC 134 note.

Subtitle B—Intellectual Property and High Technology Technical Amendments

SEC. 13201. SHORT TITLE.

This subtitle may be cited as the “Intellectual Property and High Technology Technical Amendments Act of 2002”.

SEC. 13202. CLARIFICATION OF REEXAMINATION PROCEDURE ACT OF 1999; TECHNICAL AMENDMENTS.

(a) **OPTIONAL INTER PARTES REEXAMINATION PROCEDURES.**—Title 35, United States Code, is amended as follows:

(1) Section 311 is amended—

(A) in subsection (a), by striking “person” and inserting “third-party requester”; and

(B) in subsection (c), by striking “Unless the requesting person is the owner of the patent, the” and inserting “The”.

(2) Section 312 is amended—

(A) in subsection (a), by striking the second sentence; and

(B) in subsection (b), by striking “, if any”.

(3) Section 314(b)(1) is amended—

(A) by striking “(1) This” and all that follows through “(2)” and inserting “(1)”;

(B) by striking “the third-party requester shall receive a copy” and inserting “the Office shall send to the third-party requester a copy”; and

(C) by redesignating paragraph (3) as paragraph (2).

(4) Section 315(c) is amended by striking “United States Code,”.

(5) Section 317 is amended—

(A) in subsection (a), by striking “patent owner nor the third-party requester, if any, nor privies of either” and inserting “third-party requester nor its privies”; and

(B) in subsection (b), by striking “United States Code,”.

(b) **CONFORMING AMENDMENTS.**—

(1) **APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES.**—Subsections (a), (b), and (c) of section 134 of title 35, United States Code, are each amended by striking “administrative patent judge” each place it appears and inserting “primary examiner”.

(2) **PROCEEDING ON APPEAL.**—Section 143 of title 35, United States Code, is amended by amending the third sentence to

Intellectual
Property and
High Technology
Technical
Amendments Act
of 2002.
35 USC 1 note.

read as follows: “In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.”

(c) CLERICAL AMENDMENTS.—

35 USC 311–318.

(1) Section 4604(a) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended by striking “Part 3” and inserting “Part III”.

(2) Section 4604(b) of that Act is amended by striking “title 25” and inserting “title 35”.

Applicability.
35 USC 134 note.

(d) EFFECTIVE DATE.—The amendments made by section 4605 (b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by section 1000(a)(9) of Public Law 106–113, shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113.

SEC. 13203. PATENT AND TRADEMARK EFFICIENCY ACT AMENDMENTS.

(a) DEPUTY COMMISSIONER.—

(1) Section 17(b) of the Act of July 5, 1946 (commonly referred to as the “Trademark Act of 1946”) (15 U.S.C. 1067(b)), is amended by inserting “the Deputy Commissioner,” after “Commissioner,”.

(2) Section 6(a) of title 35, United States Code, is amended by inserting “the Deputy Commissioner,” after “Commissioner,”.

(b) PUBLIC ADVISORY COMMITTEES.—Section 5 of title 35, United States Code, is amended—

(1) in subsection (i), by inserting “, privileged,” after “personnel”; and

(2) by adding at the end the following new subsection:
“(j) INAPPLICABILITY OF PATENT PROHIBITION.—Section 4 shall not apply to voting members of the Advisory Committees.”.

(c) MISCELLANEOUS.—Section 153 of title 35, United States Code, is amended by striking “and attested by an officer of the Patent and Trademark Office designated by the Director,”.

SEC. 13204. DOMESTIC PUBLICATION OF FOREIGN FILED PATENT APPLICATIONS ACT OF 1999 AMENDMENTS.

Section 154(d)(4)(A) of title 35, United States Code, as in effect on November 29, 2000, is amended—

(1) by striking “on which the Patent and Trademark Office receives a copy of the” and inserting “of”; and

(2) by striking “international application” the last place it appears and inserting “publication”.

SEC. 13205. DOMESTIC PUBLICATION OF PATENT APPLICATIONS PUBLISHED ABROAD.

Subtitle E of title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended as follows:

35 USC 102.

(1) Section 4505 is amended to read as follows:

“SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.

“Section 102(e) of title 35, United States Code, is amended to read as follows:

“(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or.”

(2) Section 4507 is amended—

(A) in paragraph (1), by striking “Section 11” and inserting “Section 10”; 35 USC 10.

(B) in paragraph (2), by striking “Section 12” and inserting “Section 11”. 35 USC 11.

(C) in paragraph (3), by striking “Section 13” and inserting “Section 12”; 35 USC 12.

(D) in paragraph (4), by striking “12 and 13” and inserting “11 and 12”; 35 USC 374.

(E) in section 374 of title 35, United States Code, as amended by paragraph (10), by striking “confer the same rights and shall have the same effect under this title as an application for patent published” and inserting “be deemed a publication”; and

(F) by adding at the end the following:

“(12) The item relating to section 374 in the table of contents for chapter 37 of title 35, United States Code, is amended to read as follows:

“374. Publication of international application.”.

(3) Section 4508 is amended to read as follows:

35 USC 10 note.

“SEC. 4508. EFFECTIVE DATE.

“Except as otherwise provided in this section, sections 4502 through 4504 and 4506 through 4507, and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by section 4504 shall additionally apply to any pending application filed before November 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Director. Except as otherwise provided in this section, the amendments made by section 4505 shall be effective as of November 29, 2000 and shall apply to all patents and all applications for patents pending on or filed after November 29, 2000. Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.”.

SEC. 13206. MISCELLANEOUS CLERICAL AMENDMENTS.

(a) **AMENDMENTS TO TITLE 35.**—The following provisions of title 35, United States Code, are amended:

(1) Section 2(b) is amended in paragraphs (2)(B) and (4)(B), by striking “, United States Code”.

(2) Section 3 is amended—

(A) in subsection (a)(2)(B), by striking “United States Code,”;

(B) in subsection (b)(2)—

(i) in the first sentence of subparagraph (A), by striking “, United States Code”;

(ii) in the first sentence of subparagraph (B)—

(I) by striking “United States Code,”; and

(II) by striking “, United States Code”;

(iii) in the second sentence of subparagraph (B)—

(I) by striking “United States Code,”; and

(II) by striking “, United States Code.” and

inserting a period;

(iv) in the last sentence of subparagraph (B), by striking “, United States Code”; and

(v) in subparagraph (C), by striking “, United States Code”; and

(C) in subsection (c)—

(i) in the subsection caption, by striking “, UNITED STATES CODE”; and

(ii) by striking “United States Code,”.

(3) Section 5 is amended in subsections (e) and (g), by striking “, United States Code” each place it appears.

(4) The table of chapters for part I is amended in the item relating to chapter 3, by striking “before” and inserting “Before”.

(5) The item relating to section 21 in the table of contents for chapter 2 is amended to read as follows:

“21. Filing date and day for taking action.”.

(6) The item relating to chapter 12 in the table of chapters for part II is amended to read as follows:

“12. Examination of Application 131”.

(7) The item relating to section 116 in the table of contents for chapter 11 is amended to read as follows:

“116. Inventors.”.

(8) Section 154(b)(4) is amended by striking “, United States Code,”.

(9) Section 156 is amended—

(A) in subsection (b)(3)(B), by striking “paragraphs” and inserting “paragraph”;

(B) in subsection (d)(2)(B)(i), by striking “below the office” and inserting “below the Office”; and

(C) in subsection (g)(6)(B)(iii), by striking “submitted” and inserting “submitted”.

(10) The item relating to section 183 in the table of contents for chapter 17 is amended by striking “of” and inserting “to”.

(11) Section 185 is amended by striking the second period at the end of the section.

(12) Section 201(a) is amended—

- (A) by striking “United States Code,”; and
 - (B) by striking “5, United States Code.” and inserting “5.”.
- (13) Section 202 is amended—
- (A) in subsection (b)(4), by striking “last paragraph of section 203(2)” and inserting “section 203(b)”;
 - and
 - (B) in subsection (c)—
 - (i) in paragraph (4), by striking “rights,” and inserting “rights,”; and
 - (ii) in paragraph (5), by striking “of the United States Code”.
- (14) Section 203 is amended—
- (A) in paragraph (2)—
 - (i) by striking “(2)” and inserting “(b)”;
 - (ii) by striking the quotation marks and comma before “as appropriate”; and
 - (iii) by striking “paragraphs (a) and (c)” and inserting “paragraphs (1) and (3) of subsection (a)”;
 - and
 - (B) in the first paragraph—
 - (i) by striking “(a)”, “(b)”, “(c)”, and “(d)” and inserting “(1)”, “(2)”, “(3)”, and “(4)”, respectively; and
 - (ii) by striking “(1.” and inserting “(a)”.
- (15) Section 209 is amended in subsections (d)(2) and (f), by striking “of the United States Code”.
- (16) Section 210 is amended—
- (A) in subsection (a)—
 - (i) in paragraph (11), by striking “5901” and inserting “5908”; and
 - (ii) in paragraph (20) by striking “178(j)” and inserting “178j”; and
 - (B) in subsection (c)—
 - (i) by striking “paragraph 202(c)(4)” and inserting “section 202(c)(4)”;
 - and
 - (ii) by striking “title.” and inserting “title.”.
- (17) The item relating to chapter 29 in the table of chapters for part III is amended by inserting a comma after “**Patent**”.
- (18) The item relating to section 256 in the table of contents for chapter 25 is amended to read as follows:
- “256. Correction of named inventor.”.
- (19) Section 294 is amended—
- (A) in subsection (b), by striking “United States Code,”; and
 - (B) in subsection (c), in the second sentence by striking “court to” and inserting “court of”.
- (20) Section 371(d) is amended by adding at the end a period.
- (21) Paragraphs (1), (2), and (3) of section 376(a) are each amended by striking the semicolon and inserting a period.
- (b) OTHER AMENDMENTS.—
- (1) Section 4732(a) of the Intellectual Property and Communications Omnibus Reform Act of 1999 is amended—
- (A) in paragraph (9)(A)(ii), by inserting “in subsection (b),” after “(ii)”;

35 USC 7 *et seq.*

(B) in paragraph (10)(A), by inserting after “title 35, United States Code,” the following: “other than sections 1 through 6 (as amended by chapter 1 of this subtitle),”.

35 USC 119.

(2) Section 4802(1) of that Act is amended by inserting “to” before “citizens”.

35 USC 10.

(3) Section 4804 of that Act is amended—

(A) in subsection (b), by striking “11(a)” and inserting “10(a)”; and

35 USC 12.

(B) in subsection (c), by striking “13” and inserting “12”.

35 USC 382.

(4) Section 4402(b)(1) of that Act is amended by striking “in the fourth paragraph”.

SEC. 13207. TECHNICAL CORRECTIONS IN TRADEMARK LAW.

(a) AWARD OF DAMAGES.—Section 35(a) of the Act of July 5, 1946 (commonly referred to as the “Trademark Act of 1946”) (15 U.S.C. 1117(a)), is amended by striking “a violation under section 43(a), (c), or (d),” and inserting “a violation under section 43(a) or (d),”.

(b) ADDITIONAL TECHNICAL AMENDMENTS.—The Trademark Act of 1946 is further amended as follows:

(1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is amended in the first sentence by striking “specifying the date of the applicant’s first use” and all that follows through the end of the sentence and inserting “specifying the date of the applicant’s first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce.”.

(2) Section 1(e) (15 U.S.C. 1051(e)) is amended to read as follows:

“(e) If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.”.

(3) Section 8(f) (15 U.S.C. 1058(f)) is amended to read as follows:

“(f) If the registrant is not domiciled in the United States, the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name

DOCKET NO.: JJCC-0003
Application No.: 09/981,516
Office Action Dated: May 19, 2005

PATENT

B

Public Law 106-113
106th Congress

An Act

Making consolidated appropriations for the fiscal year ending September 30, 2000,
and for other purposes.

Nov. 29, 1999
[H.R. 3194]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the following sums are appropriated, out of any money in the Treasury not otherwise appropriated, for the several departments, agencies, corporations and other organizational units of the Government for the fiscal year 2000, and for other purposes, namely:

DIVISION A

DISTRICT OF COLUMBIA APPROPRIATIONS

TITLE I—FISCAL YEAR 2000 APPROPRIATIONS

FEDERAL FUNDS

District of
Columbia
Appropriations
Act, 1999.

FEDERAL PAYMENT FOR RESIDENT TUITION SUPPORT

For a Federal payment to the District of Columbia for a program to be administered by the Mayor for District of Columbia resident tuition support, subject to the enactment of authorizing legislation for such program by Congress, \$17,000,000, to remain available until expended: *Provided*, That such funds may be used on behalf of eligible District of Columbia residents to pay an amount based upon the difference between in-State and out-of-State tuition at public institutions of higher education, usable at both public and private institutions of higher education: *Provided further*, That the awarding of such funds may be prioritized on the basis of a resident's academic merit and such other factors as may be authorized: *Provided further*, That if the authorized program is a nationwide program, the Mayor may expend up to \$17,000,000: *Provided further*, That if the authorized program is for a limited number of States, the Mayor may expend up to \$11,000,000: *Provided further*, That the District of Columbia may expend funds other than the funds provided under this heading, including local tax revenues and contributions, to support such program.

FEDERAL PAYMENT FOR INCENTIVES FOR ADOPTION OF CHILDREN

For a Federal payment to the District of Columbia to create incentives to promote the adoption of children in the District of Columbia foster care system, \$5,000,000: *Provided*, That such funds shall remain available until September 30, 2001 and shall be used

all applications filed under section 111(a) of title 35, United States Code, on or after June 8, 1995, and all applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after June 8, 1995; and

(2) do not apply to applications for design patents under chapter 16 of title 35, United States Code.

Subtitle E—Domestic Publication of Patent Applications Published Abroad

SEC. 4501. SHORT TITLE.

This subtitle may be cited as the “Domestic Publication of Foreign Filed Patent Applications Act of 1999”.

SEC. 4502. PUBLICATION.

(a) PUBLICATION.—Section 122 of title 35, United States Code, is amended to read as follows:

“§ 122. Confidential status of applications; publication of patent applications

“(a) CONFIDENTIALITY.—Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

“(b) PUBLICATION.—

“(1) IN GENERAL.—(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

“(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

“(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

“(2) EXCEPTIONS.—(A) An application shall not be published if that application is—

“(i) no longer pending;

“(ii) subject to a secrecy order under section 181 of this title;

“(iii) a provisional application filed under section 111(b) of this title; or

“(iv) an application for a design patent filed under chapter 16 of this title.

“(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the

application shall not be published as provided in paragraph (1).

“(ii) An applicant may rescind a request made under clause (i) at any time.

“(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

“(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

“(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

“(c) PROTEST AND PRE-ISSUANCE OPPOSITION.—The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

“(d) NATIONAL SECURITY.—No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.”

(b) STUDY.—

(1) **IN GENERAL.**—The Comptroller General shall conduct a 3-year study of the applicants who file only in the United States on or after the effective date of this subtitle and shall provide the results of such study to the Judiciary Committees of the House of Representatives and the Senate.

(2) **CONTENTS.**—The study conducted under paragraph (1) shall—

(A) consider the number of such applicants in relation to the number of applicants who file in the United States and outside of the United States;

(B) examine how many domestic-only filers request at the time of filing not to be published;

(C) examine how many such filers rescind that request or later choose to file abroad;

(D) examine the status of the entity seeking an application and any correlation that may exist between such status and the publication of patent applications; and

(E) examine the abandonment/issuance ratios and length of application pendency before patent issuance or abandonment for published versus unpublished applications.

SEC. 4503. TIME FOR CLAIMING BENEFIT OF EARLIER FILING DATE.

(a) **IN A FOREIGN COUNTRY.**—Section 119(b) of title 35, United States Code, is amended to read as follows:

“(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

“(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

“(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.”.

(b) **IN THE UNITED STATES.**—

(1) **IN GENERAL.**—Section 120 of title 35, United States Code, is amended by adding at the end the following: “No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept

an unintentionally delayed submission of an amendment under this section.”.

(2) **RIGHT OF PRIORITY.**—Section 119(e)(1) of title 35, United States Code, is amended by adding at the end the following: “No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.”.

SEC. 4504. PROVISIONAL RIGHTS.

Section 154 of title 35, United States Code, is amended—

(1) in the section caption by inserting “; **provisional rights**” after “**patent**”; and

(2) by adding at the end the following new subsection: “(d) **PROVISIONAL RIGHTS.**—

“(1) **IN GENERAL.**—In addition to other rights provided by this section, a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application for such patent under section 122(b), or in the case of an international application filed under the treaty defined in section 351(a) designating the United States under Article 21(2)(a) of such treaty, the date of publication of the application, and ending on the date the patent is issued—

“(A)(i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States; or

“(ii) if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and

“(B) had actual notice of the published patent application and, in a case in which the right arising under this paragraph is based upon an international application designating the United States that is published in a language other than English, had a translation of the international application into the English language.

“(2) **RIGHT BASED ON SUBSTANTIALLY IDENTICAL INVENTIONS.**—The right under paragraph (1) to obtain a reasonable royalty shall not be available under this subsection unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.

“(3) **TIME LIMITATION ON OBTAINING A REASONABLE ROYALTY.**—The right under paragraph (1) to obtain a reasonable royalty shall be available only in an action brought not later than 6 years after the patent is issued. The right under paragraph (1) to obtain a reasonable royalty shall not be affected by the duration of the period described in paragraph (1).

"(4) REQUIREMENTS FOR INTERNATIONAL APPLICATIONS.—

"(A) EFFECTIVE DATE.—The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date on which the Patent and Trademark Office receives a copy of the publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the international application in the English language.

"(B) COPIES.—The Director may require the applicant to provide a copy of the international application and a translation thereof."

SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.

Section 102(e) of title 35, United States Code, is amended to read as follows:

"(e) The invention was described in—

"(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

"(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or".

SEC. 4506. COST RECOVERY FOR PUBLICATION.

The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office shall recover the cost of early publication required by the amendment made by section 4502 by charging a separate publication fee after notice of allowance is given under section 151 of title 35, United States Code.

SEC. 4507. CONFORMING AMENDMENTS.

The following provisions of title 35, United States Code, are amended:

(1) Section 11 is amended in paragraph 1 of subsection (a) by inserting "and published applications for patents" after "Patents".

(2) Section 12 is amended—

(A) in the section caption by inserting "**and applications**" after "**patents**"; and

(B) by inserting "and published applications for patents" after "patents".

(3) Section 13 is amended—

(A) in the section caption by inserting "**and applications**" after "**patents**"; and

(B) by inserting “and published applications for patents” after “patents”.

(4) The items relating to sections 12 and 13 in the table of sections for chapter 1 are each amended by inserting “and applications” after “patents”.

(5) The item relating to section 122 in the table of sections for chapter 11 is amended by inserting “; publication of patent applications” after “applications”.

(6) The item relating to section 154 in the table of sections for chapter 14 is amended by inserting “; provisional rights” after “patent”.

(7) Section 181 is amended—

(A) in the first undesignated paragraph—

(i) by inserting “by the publication of an application or” after “disclosure”; and

(ii) by inserting “the publication of the application or” after “withhold”;

(B) in the second undesignated paragraph by inserting “by the publication of an application or” after “disclosure of an invention”;

(C) in the third undesignated paragraph—

(i) by inserting “by the publication of the application or” after “disclosure of the invention”; and

(ii) by inserting “the publication of the application or” after “withhold”; and

(D) in the fourth undesignated paragraph by inserting “the publication of an application or” after “and” in the first sentence.

(8) Section 252 is amended in the first undesignated paragraph by inserting “substantially” before “identical” each place it appears.

(9) Section 284 is amended by adding at the end of the second undesignated paragraph the following: “Increased damages under this paragraph shall not apply to provisional rights under section 154(d) of this title.”

(10) Section 374 is amended to read as follows:

“§ 374. Publication of international application

“The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall confer the same rights and shall have the same effect under this title as an application for patent published under section 122(b), except as provided in sections 102(e) and 154(d) of this title.”

(11) Section 135(b) is amended—

(A) by inserting “(1)” after “(b)”; and

(B) by adding at the end the following:

“(2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.”

SEC. 4508. EFFECTIVE DATE.

Sections 4502 through 4507, and the amendments made by such sections, shall take effect on the date that is 1 year after

the date of the enactment of this Act and shall apply to all applications filed under section 111 of title 35, United States Code, on or after that date, and all applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after that date. The amendments made by sections 4504 and 4505 shall apply to any such application voluntarily published by the applicant under procedures established under this subtitle that is pending on the date that is 1 year after the date of the enactment of this Act. The amendment made by section 4504 shall also apply to international applications designating the United States that are filed on or after the date that is 1 year after the date of the enactment of this Act.

Subtitle F—Optional Inter Partes Reexamination Procedure

SEC. 4601. SHORT TITLE.

This subtitle may be cited as the “Optional Inter Partes Reexamination Procedure Act of 1999”.

SEC. 4602. EX PARTE REEXAMINATION OF PATENTS.

The chapter heading for chapter 30 of title 35, United States Code, is amended by inserting “EX PARTE” before “REEXAMINATION OF PATENTS”.

SEC. 4603. DEFINITIONS.

Section 100 of title 35, United States Code, is amended by adding at the end the following new subsection:

“(e) The term ‘third-party requester’ means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner.”.

SEC. 4604. OPTIONAL INTER PARTES REEXAMINATION PROCEDURES.

(a) IN GENERAL.—Part 3 of title 35, United States Code, is amended by adding after chapter 30 the following new chapter:

“CHAPTER 31—OPTIONAL INTER PARTES REEXAMINATION PROCEDURES

“Sec.

“311. Request for inter partes reexamination.

“312. Determination of issue by Director.

“313. Inter partes reexamination order by Director.

“314. Conduct of inter partes reexamination proceedings.

“315. Appeal.

“316. Certificate of patentability, unpatentability, and claim cancellation.

“317. Inter partes reexamination prohibited.

“318. Stay of litigation.

“§ 311. Request for inter partes reexamination

“(a) IN GENERAL.—Any person at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

“(b) REQUIREMENTS.—The request shall—

“(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and